REMARKS

Claims 62 and 71 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The recitation to "checks" in these claims is in error and should instead refer to "bills." Amendments to claims 62 and 71 are presented herein to correct the indefiniteness of these claims. Withdrawal of the rejection is requested.

Claims 7, 18, 31, 36, 37, 45, 50, 51, 61, and 70 have been objected to as being dependent on a rejected base claim. Applicants thank the Examiner for the indication of allowable subject matter.

Applicants note that the Office Action does not substantively address the patentability of claims 54 and 64 with respect to an art reference. The only rejection applied against these claims is an obviousness-type double patenting rejection. Applicants accordingly submit that these claims should also be in condition for favorable action and allowance subject to resolution, as discussed below, of the obviousness-type double patenting rejection.

Claims 53, 55-56, 59-60, 62-63, 65, 68-69 and 71 were rejected under 35 U.S.C. 102(e) as being anticipated by Conant.

Turning first to claim 53, Applicants have amended the claim to recite that the bill imager captures full bill images. Claim 56 has been amended to recite that the memory stores full bill images. Conant teaches the imaging of the bill corners and further teaches the storage in the image memory of pixel data associated with those corner images (see, col. 5, lines 39-45 and col. 7, lines 10-13). There is no teaching or suggestion in Conant for obtaining through imaging and then storing in memory of full bill images wherein the bills are transported past the bill imager in

the manner recited by claims 53 and 56. Applicants accordingly request that the Section 102(e) rejection of claim 53 be withdrawn. Dependent claims 54-62 are asserted to be patentable over Conant for at least the same reasons as claim 53.

Claim 63 is a method analog to claim 53. Similar amendments have been made to claims 63 and 65, and Applicants assert that claims 63 and 65 define over Conant for at least the same reasons as recited above with respect to claims 53 and 56. Dependent claims 64-71 are asserted to be patentable over Conant for at least the same reasons as claim 63.

Claims 57 and 66 were rejected under 35 U.S.C. 103(a) as being unpatentable over Conant in view of Cahill. Applicants respectfully traverse. Dependent claims 57 and 66 are patentable of the cited art at least for the same reasons as their respective independent claims 53 and 63.

Claims 58 and 67 were rejected under 35 U.S.C. 103(a) as being unpatentable over Conant in view of Raterman. Applicants respectfully traverse. Dependent claims 58 and 67 are patentable of the cited art at least for the same reasons as their respective independent claims 53 and 63.

Claims 1, 3-5, 10-12, 14-16, 21-25, 27-29, 34-35, 38-39, 41-43, 48-49 and 52 were rejected under 35 U.S.C. 103(a) as being unpatentable over Holt in view of Conant. Applicants respectfully traverse.

The Examiner asserts that Holt teaches check processing wherein checks are imaged. The Examiner further correctly concedes that Holt, while inherently teaching that checks have wide and narrow dimensions, fails to teach transporting checks with an orientation where the

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narrow dimension is parallel to the direction of transport (i.e., with their wide edge leading). The Examiner accordingly cites to Conant which teaches processing currency bills past an image scanner with the wide edge of the currency bill leading, and suggests it would have been obvious to one skilled in the art to use wide edge leading check transport in Holt because wide edge currency bill processing is taught by Conant. The Examiner's reliance on Conant is misplaced for a number of reasons.

First, Applicants note that Holt teaches not only imaging of the transported checks (see, Figure 2A, scanner 331) but also performing MICR printing (Figure 2A, printer 339) and MICR reading (Figure 2A, reader 337) on the transported checks. As the Examiner is no doubt well aware, MICR information is printed along the bottom edge of the check. It is also well known in the art that MICR printers and MICR readers (such as printer 339 and reader 337 in Holt) are devices which process checks with the wide edge parallel to the direction of transport (i.e., with the narrow edge leading). The reason for this is that it is only with narrow edge leading transport that MICR data can printed on, and read from, the bottom edge of the check. There is no teaching or suggestion in Holt, as conceded by the Examiner, for processing the checks with the wide edge leading. In fact, Applicants submit that Holt, through the presence of MICR printer 339 and MICR scanner 339 in the check transport path which require narrow edge leading transport, specifically teaches away from the claimed invention. Given that teaching, and the orientation requirements of MICR processing, there would be no motivation by one skilled in the art to look to the transport technique taught by Conant and consider any form of wide edge leading check transport as is claimed by Applicants.

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Additionally, combining Conant with Holt would effectively destroy the disclosed operation of Holt which utilizes MICR processing in combination with check imaging. The reason for this is that the Conant wide edge leading transport technique is wholly incompatible with the known MICR printing and reading techniques, and in particular with those techniques as taught by Holt, which require narrow edge leading transport in order to print on, and read from, the bottom edge of the check. If wide edge leading processing were utilized in Holt, as suggested by the Examiner, then the system as disclosed by Holt would not be capable of performing the MICR processing operations which are shown in Figure 2A. When the proposed combination effectively destroys an operation or functionality of one of the references, that combination is improper. Still further, because wide edge leading processing would preclude MICR printing and reading as taught by Holt, one skilled in the art would have no motivation to consider the teachings of Conant.

Lastly, Applicants note that Conant is a currency processing teaching. The claims at issue are, conversely, directed to check processing. The Examiner generally refers to a "financial document" so as to in essence lump currency bills and checks into a single document category for purposes of supporting the proposed combination. What the Examiner is asserting is that whatever works for currency bills in Conant must be equally applicable to checks in Holt. However, as discussed above at least with respect to the issue of MICR processing, there is no equal applicability in the present case. The lumping of checks and currency bills together with respect to document transport in a wide edge leading manner, as claimed, is clearly not a workable solution when both imaging and MICR processing is required. As clearly shown by

the prior art, when MICR is implicated in check processing, the transport is solely narrow edge

leading so as to give MICR devices proper access to the bottom edge of the check.

The Examiner further notes that Conant suggests that the transport orientation of currency

bills with respect to direction of travel is a matter of design choice. While this may be true with

respect to a currency bill, given the unique features of check processing discussed above, and

especially in connection with MICR printing and reading, this is clearly not true with respect to

checks. The prior art clearly teaches printing and reading MICR data using narrow edge leading

check transport. The only teaching or suggestion for wide edge leading processing of checks,

even in the context of MICR processing, comes from Applicants' own disclosure. The Examiner

is well aware of the prohibition against using Applicants' own disclosure as a road map for

making out a Section 103 rejection.

Claims 1, 12, 25 and 39 are all independent claims which recite check processing for

imaging where the checks are transported with their narrow dimension parallel to the transport

path (i.e., wide edge leading). For at least the reasons recited above, Applicants respectfully

submit that these claims are patentable over the cited art. Dependent claims 3-5, 10-11, 14-16,

21-24, 27-29, 34-35, 38, 41-43, 48-49 and 52 are patentable of the cited art at least for the same

reasons as their respective independent claims 1, 12, 25 and 39.

Claims 2, 6, 8, 13, 17, 19, 26, 30, 32, 40, 44 and 46 were rejected under 35 U.S.C. 103(a)

as being unpatentable over Holt in view of Conant and Cahill. Applicants respectfully traverse.

Dependent claims 2, 6, 8, 13, 17, 19, 26, 30, 32, 40, 44 and 46 are patentable of the cited art at

least for the same reasons as their respective independent claims 1, 12, 25 and 39.

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The Examiner cites to Cahill and notes a teaching in Cahill for imaging checks and reading through an OCR process the MICR data from each check. Claims 2, 13, 26 and 40 are directed to recognizing from a check image the imprinted MICR data. These dependent claims, however, further include the limitations of their respective independent claims 1, 12, 25 and 39 which recite that the checks have to be transported with their narrow dimension parallel to the transport path (i.e., wide edge leading). Applicants point out that Cahill, like Holt, similarly teaches a check transport system that is narrow edge leading. The Examiner's attention is directed to Cahill Figure 3 which clearly illustrates the checks 1 being transported with their narrow edges leading. To the extent there is any ambiguity in Cahill concerning check transport orientation, Applicant further directs the Examiner's attention to magnetic MICR reader 205 which receives checks from the input hopper 203. As discussed above, it is well known in the art that magnetic MICR readers require narrow edge leading check transport in order to allow for the magnetic data to be read from the bottom edge of the check. Again, there is no teaching or suggestion in the cited art for MICR processing in the context of wide edge leading check transport. And also, any proposed combination of these references would effectively destroy the disclosed operation of Cahill, as in Holt (discussed above), which utilizes MICR processing in combination with check imaging. Claims 2, 13, 26 and 40 are accordingly patentable over the cited art combination.

Claims 9, 20, 33 and 47 were rejected under 35 U.S.C. 103(a) as being unpatentable over Holt in view of Conant and Raterman. Applicants respectfully traverse. Dependent claims 9, 20,

33 and 47 are patentable of the cited art at least for the same reasons as their respective independent claims 1, 12, 25 and 39.
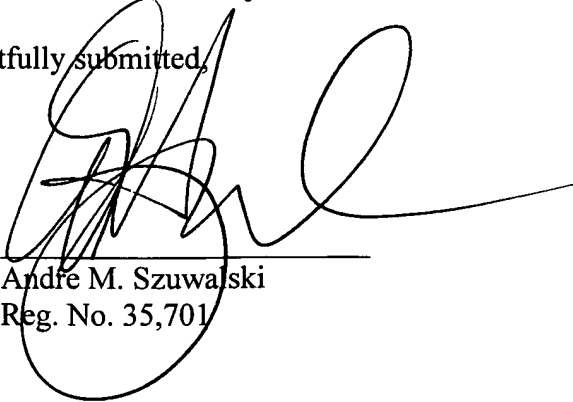
Claims 1, 8-12, 20-25, 32-35, 38-39, 46-49 and 52 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6 and 17 of U.S. Patent No. 6,647,136 in view of Conant. Applicant respectfully traverses for at least the reasons recited above in that Conant's teachings for currency bill processing are not relevant the check processing as claimed.

Claims 53-55, 57-60, 63-64 and 66-69 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7, 13 and 18 of U.S. Patent No. 6,603,872 in view of Conant. Applicant respectfully traverses for at least the reasons recited above with respect to the full imaging of currency bills.

In an effort to advance prosecution on the merits, and without any admission as to the propriety of the obviousness-type double patenting rejections asserted by the Examiner, Applicants submits herewith a terminal disclaimer to overcome these rejections.

Respectfully submitted,

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